



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,176	09/27/2004	Olivier Bouesnard	4004-061-30	5223

30448 7590 09/17/2007
AKERMAN SENTERFITT
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
----------	--------------

1762

MAIL DATE	DELIVERY MODE
-----------	---------------

09/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/509,176	Applicant(s) BOUESNARD ET AL.	
	Examiner Frederick J. Parker	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,15,17,26,29-42 and 45-49 is/are pending in the application.
4a) Of the above claim(s) 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,15,17,26,29-33,38-42,45-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Election/Restrictions

1. Applicants did not further contest the Restriction which was made Final in the previous Office Action.

Specification

2. The amendments in response to the Specification Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

3. The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 102

4. The amendments in response to the 35 USC 102 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 103

5. The amendments in response to the 35 USC 103 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections. The following new rejections are necessitated by amendment.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1,4,13,15,17,26,29,32,38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossi US 6521541 in view of Turner US 4724011.

Rossi teaches to selectively coat portions of a substrate by applying a crystalline colloid maskant layer of, for example, inorganic materials such as silica, on the substrate in the form of an aqueous sol, at least minimally drying the maskant layer, applying a coating to the particle masked and unmasked portions of the substrate, and then removal of the masking material by sonication in water. See Example, col. 3, 29-54, etc. The reference further teaches to utilize particles of about 30-2500nm to form a crystalline masking array wherein the particles are within a standard deviation of about 1% of particle diameter, col. 4, 15-29. Rossi teaches applying coatings in vacuum using vapor deposition methods (see example, etc) per claims 1,26. The suggestion of glass substrates is expressed on col. 1, 59-62. Use of a screen to apply the masking agent is not taught. However, Turner et al teaches on col. 8, 50 bridging col. 9,5 that inorganic maskants are applied to substrates by patterned screen printing prior to coating by vacuum deposition methods to apply patterned coatings, after which the maskant is removed by a solvent wash step. In both cases the maskant materials must be inert to the subsequently applied coatings. While specific viscosities are not cited, it is the Examiner's position that, absent a clear and convincing showing of synergistic or unexpected results to the contrary, defining a specific viscosity for a coating method and application is within the purview of one of ordinary skill to provide, in this case, masked pattern portions with desired definition and sufficient properties to prevent the deposition of subsequently applied coatings. Hence viscosity limitations of the maskant are simply process parameters determined by routine experimentation for the reasons cited above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the processes of Rossi by incorporating the screen printing means of Turner et al

to apply the inorganic maskant material because Turner expressly discloses screen printing for applying similar solvent-removable masking materials prior to applying similar coating methods.

8. Claims 2,3,15,28-33,45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossi US 6521541 in view of Turner US 4724011 and further in view of Boaz US 4477486.

Rossi and Turner are cited for the same reasons previously discussed, which are incorporated herein. Additional maskant agents are not cited.

Boaz teaches a method of selectively coating glass surfaces in which a maskant agent comprising inert inorganic particles (alumina, calcium carbonate (an AE carbonate per claim 3), zirconia, **silica**, silicates (encompassing enamel silicates), etc see col. 5, 8-24) is selectively applied to the glass; the masked glass is then coated with a coating which would have inherently been solar-controlling per claim 30; and then the maskant material is removed by washing which includes water and other solvents, particularly since water is commonly used for washing by virtue of its safety, availability, and washing properties. Since the process takes place at ambient conditions / temperature, between maskant application and subsequent coating, at least a minimal amount of water evaporation/ drying inherently occurs per claim 29. Boaz teaches the equivalence of silica particles with calcium carbonate (an AE carbonate) and silicates (encompassing enamels) so that it would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Rossi in view of Turner using the additional maskant particles of Boaz because they are taught to be successful equivalent maskant particles for similar coating maskant purposes.

Art Unit: 1762

As to claims 32-33, it is the Examiner's position that what substrate portions are and are not masked would have been determined by the end-use application and end-use product, choices which are readily within the purview of one skilled in the art to provide the utility and specifications required of the final product being made. It has been established that design incentives, market forces, predictability, use of ordinary skill and common sense, and ordinary capabilities or ingenuity of one skilled in the art articulated by the Examiner may be relied upon to support obviousness. KSR 82 USPQ2d 1396.

Response to Arguments

Applicants state they have amended claims to overcome the rejections under 35 USC 102, which they have done, but simply shifting limitations around precipitates a prior art rejection under 35 USC 103. Applicants neither state nor discuss the reasons as to why their claims patentably distinguish over the prior art. The Examiner has rejected all claims under 35 USC 103 and by so doing has established a prima facie case of obviousness in response to Applicants amendments.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


Art Unit: 1762

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp